



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,798	12/09/2003	Fred M. Mendelsohn		4324

7590 07/31/2006

Arthur W. Fisher, III
Suite 316
5553 West Waters Avenue
Tampa, FL 33634

EXAMINER

KOSLOW, CAROL M

ART UNIT PAPER NUMBER

1755

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,798

Applicant(s)

MENDELSON, FRED M.

Examiner

C. Melissa Koslow

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 29-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 1755

This action is in response to applicant's amendment of 26 June 2006. The newly submitted oath is acceptable and thus the objection to the oath is withdrawn. The amendments to the claims have overcome the objections to the claims, the 35 USC 112 first paragraph rejections and the art rejection. All the 35 USC 112, second paragraph rejections, with the exception of the rejection that the actual composition is unclear, are withdrawn due to the amendments to the claims. Applicant's arguments with respect to the remaining rejection have been fully considered but they are not persuasive.

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 30 and 32 of this application. The specification teaches an effective pupil lumens per watt of about 44.509. This teaching does not support claim 30 which teaches the an effective pupil lumens per watt is about 44.509 or greater nor claim 32 which teaches an effective pupil lumens per watt of about 45.

The provisional application upon which priority is claimed provides adequate support under 35 U.S.C. 112 for claims 29, 31 and 33-35 of this application.

The disclosure is objected to because of the following informalities:

A preliminary examination of this application reveals that it includes terminology which is so different from that which is generally accepted in the art to which this invention pertains that a proper search of the prior art cannot be made. The disclosed individual compounds are not phosphors. The Examiner has been unable to find any evidence that the claimed compounds are phosphors. Applicant is required to provide a clarification of these matters or correlation with art-accepted terminology so that a proper comparison with the prior art can be made. Applicant

Art Unit: 1755

should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Table 1 and claim 29 teach each of the disclosed compounds are phosphorescent or phosphors. Elemental europium, elemental terbium, elemental calcium, strontium boride, yttrium oxide, barium yttrium oxide and barium borate are not phosphorescent.

Claims 30 and 32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The specification teaches an effective pupil lumens per watt of about 44.509. This teaching does not support claim 30 which teaches the an effective pupil lumens per watt is about 44.509 or greater nor claim 32 which teaches an effective pupil lumens per watt of about 45. Thus the subject matter of these claims are new matter.

Claims 29-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The actual composition of the phosphor is unclear since disclosed compounds are not phosphors, as discussed above. The Examiner has been unable to find any evidence that the claimed compounds are phosphors.

Applicants argue the compounds in U.S. patent 5,122,710 show the claimed compounds are phosphors. The compounds in U.S. patent 5,122,710 are different from that claimed. The reference teaches, for example, $Y_2O_3:Eu$, which one of ordinary skill in the art knows is also

Art Unit: 1755

written as $(Y_{1-x}Eu_x)_2O_3$. Thus the reference teaches not teach europium and yttrium oxide, individually, as now claimed. While the claims no longer use the word "phosphor", the statement that the compounds emit light in a fluorescent lamp implicitly teaches the compounds are phosphors. The cited art of record show and one of ordinary skill in the art would be expected to know that for strontium boride, yttrium oxide, barium yttrium oxide and barium borate to be phosphorescent, they must be doped with europium, terbium or calcium ions. This is not what is taught or claimed. The amendments to the claims and the arguments do not clarify what is the actual composition of the material which is coated inside a fluorescent lamp and emits light.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.


Art Unit: 1755

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
July 27, 2006


C. Melissa Koslow
Primary Examiner
Tech. Center 1700